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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,651	01/13/2005	Roman Lenz	EL/2-22714/A/PCT	9351

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CIBA SPECIALTY CHEMICALS CORPORATION  
PATENT DEPARTMENT  
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EXAMINER
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SANDERS, KRIELLION ANTIONETTE

ART UNIT	PAPER NUMBER
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1714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/521,651

Applicant(s)

LENZ ET AL.

Examiner

Kriellion A. Sanders

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/26/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1714

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rochat et al, US Patent No. 4,579,949 in view of Wallquist et al, US Patent No. 5,738,719.

Applicant states at page 7 of the present specification, that the diketopyrroles of formula (1) are produced analogously to generally known methods as described in Rochat et al.

Therefor, applicant did not invent the method of claim 4.

Rochat et al. discloses polymeric compositions comprising diketopyrrole pigments that correspond structurally to those of the presently claimed invention, and are produced by an analogous method. No patentable difference may readily be ascertained between the present and patented inventions. See Rochat et al at col. 4, lines 8-28 and col. 7, line 60 through col. 8, line 4. Rochat et al indicates that polyacrylates may be colored with the diketopyrrole pigments of the invention. See col. 7, line 60 through col. 8, line 4.

Wallquist et al in example 5 discloses particulate or powder diketopyrroles that are a red transparent shade. The phrase blue-tinged red shade is subjective. This phrase cannot be said to conclusively differentiate over the patented diketopyrroles. The ordinary practitioner is aware of processes to form diketopyrroles that are in powder form or are particulate in nature.

***Response to Arguments***

1. Applicant's arguments filed 10/26/2006 have been fully considered but they are not persuasive.

Applicant attempts to differentiate over the diketopyrroles of the patented inventions by including claim limitations that the present diketopyrroles are of a blue-tinged red shade.

Wallquist et al in example 5 indicates that the diketopyrroles are a red transparent shade. This documents that diketopyrroles colored in such a manner are conventional. The phrase blue-tinged red shade is subjective. This phrase cannot be said to conclusively differentiate over the patented diketopyrroles.

2. Applicant attempts to differentiate over the diketopyrroles of the patented inventions by including claim limitations that the present diketopyrroles having a transmission at 570-580 nm of less than 5% and a transmission at 615 nm of at least 80%. Applicant further indicates that this light transmission is directly correlative to the shade of the pigment particles. Because the present diketopyrroles are structurally identical to those of the Rochat et al. prior art and are produced by an analogous process, it is not clear that they differentiate over the diketopyrroles of and Rochat et al.

3. At page 11 of the response, applicant states:

“It is true that the process of claim 4 is analogous to that of US 4,597,949 as stated on page 7 of the instant specification, however the process is not the same and the differences are significant. To better highlight the differences, Applicants have amended claim 4 to include the further limitation that the suspension resulting after addition of the succinic acid diester is discharged into a mixture comprising methanol and acetic acid at

Art Unit: 1714

a temperature below 30°C. US 4,597,949 teaches discharging the reaction mixture into a hydrolysis medium at temperatures below 80°C (column 7 / lines 29-31). Hydrolysis takes place slowly without preliminary precipitation. The only description of the hydrolysis medium is that water, alcohols or acids can be used (column 6 / lines 16-19). In the examples of '949, hydrolysis is always performed by slow addition of methanol followed by acetic acid at 65°C (examples 1-46) or a methanol/acetic acid mixture at 60°C (examples 47 - 51). The difference between the two processes is related to the small particle size of the pigment as related in the amendments to claim 2 from which claim 4 depends.

This argument is not persuasive because the particle size is not a process limitation. There is nothing to differentiate between the present and patented processes. Also, the use of a temperature below 80 degrees C. by Rochat, encompasses applicant's temperature limitation of below 30 degrees C.

Likewise, it would have been obvious to the obvious practitioner to formulate specific sizes of particulate matter from the process of Rochat.

4. Claims 1-10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rochat et al, US Patent No. 4,579,949 as applied to claims 1-10 and 12-14 above, and further in view of WO 02/10288.

The world patent teaches that diketopyrroles are commonly used to make colour filters. See page 8, fourth complete paragraph. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to employ the diketopyrroles of Rochat et al. in a colour filter in the manner suggested by the World patent.

Art Unit: 1714

*Response to Arguments*

5. Applicant's arguments filed 10/26/2006 have been fully considered but they are not persuasive. Applicant states:

As disclosed in the specification (see for example the end of page 2), color filters have specific requirements that are not met by existing DPPs. The very steep increase in transmission at about 600 nm of the instant pigments as seen in Figure 1 allows the instant pigments to fulfill these requirements. Applicants respectfully aver that these transmission characteristics could not be expected from pigments of the prior art and that these valuable pigments, and the filters made with them, are only available due to the instant invention.

This argument is not persuasive because although applicant argues that existing DPPs do not meet the requirements for color filters, the world patent teaches that diketopyrroles are commonly used to make colour filters. Therefor applicant's statement is not convincing.

*Conclusion*

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 1714

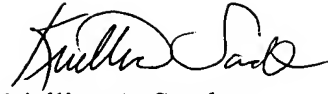
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kriellion A. Sanders whose telephone number is 571-272-1122. The examiner can normally be reached on Monday through Thursday 6:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 1714

A handwritten signature in black ink, appearing to read "Kriellion Sanders". The signature is fluid and cursive, with the first name "Kriellion" and last name "Sanders" clearly distinguishable.

Kriellion A. Sanders  
Primary Examiner  
Art Unit 1714

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